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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,568	01/16/2002	Xavier Blin	05725.1018-00	1780

7590

06/12/2003

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EXAMINER

VENKAT, JYOTHSNA A

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 06/12/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary*Feb 2003*

Application No.

10/046,568

Applicant(s)

BLIN ET AL.

Examiner

JYOTHSNA A VENKAT

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 49-105 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 49-105 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☒ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 1615

DETAILED ACTION

Receipt is acknowledged of extension of time, and amendment B filed on 3/23/03.

Claims 49-105 are pending in the application and the status of the application is as follows:

Priority

Receipt is acknowledged of domestic priority under 119(e).

The following rejections are maintained for reasons of record.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 49-59, 61, 65-78, 82-84, 86-88 and 92-98 are rejected under 35 U.S.C. 102(b) as being anticipated by U. S. Patent 4,655,836(836).

The instant application is claiming a structured nail polish composition comprising:

1. *At least one liquid organic phase comprising:*

a. Volatile organic solvent

b. First polymer comprising;

i) A polymer backbone comprising hydrocarbon-based repeating units, wherein the e unit has one heteroatom

Art Unit: 1615

ii) At least one fatty chain containing 6-12 carbon atoms and chosen from at least one pendent fatty chain and one terminal fatty chain where in the fatty chain is linked to the hydrocarbon-based units and is optionally functionalized

2. Second film-forming polymer (species is claimed in claim 74)

3. The organic phase additionally has non volatile oil

4. Additives in claim 88.

The patent at col.2, discloses polyamides, which is claimed as “ anti-slip agent”.

Applicants at page 12 disclose that the polymer can be polyamide resin. See col.2 for the ranges which overlap for the fatty chain, see col.6, lines 35-40, see col.1, lines 60-62 for the additives (claim 88, see col.3, lines 45 et seq for the volatile organic solvent. The solvents disclosed in the patent are volatile and therefore the patent anticipates claims 68-72, see claim 1 of the patent which has both the “ nitrocellulose and polyamide resin “ which reads on the claimed second film-forming polymer (claims 73-74). The preamble does not carry any patentable weight to claims as the claims are drawn to compositions. The polymer is the same and therefore the average molecular weight claimed inherent absence of evidence to the contrary. The expression comprising is inclusive of all the unrecited ingredients in major amounts.

Arguments

3. Applicant's arguments filed 3/23/03 have been fully considered but they are not persuasive.

4. Applicants argue that claims 49, 92, 98-99 have been amended to recite” *wherein said at least one volatile organic solvent and said at least one first polymer are present in the nail polish*

Art Unit: 1615

composition in a combined amount to give a structured nail polish composition" and therefore patent '836 does not anticipate the claimed invention.

Response to Arguments

In response to the above argument, it is the examiners position that the patent '836 is drawn to non-slip coating compositions. Applicant's attention is drawn to claim 1. The instant application is also drawn to nail compositions, which is for coating the nails. Thus both the compositions are drawn to coating. Both the compositions use the same polymer and volatile organic solvent. The amended expression does not carry any patentable weight.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 49-105 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of GB patent 2,196,978('978), U. S. Patent 6,402, 408 ('408).

Art Unit: 1615

The instant application is claiming a structured nail polish composition comprising:

1. *At least one liquid organic phase comprising:*
 - a. *Volatile organic solvent*
 - b. *First polymer comprising:*
 - i) *A polymer backbone comprising hydrocarbon-based repeating units, wherein the e unit has one heteroatom*
 - ii) *At least one fatty chain containing 6-12 carbon atoms and chosen from at least one pendent fatty chain and one terminal fatty chain where in the fatty chain is linked to the hydrocarbon-based units and is optionally functionalized*
2. *Second film-forming polymer (species is claimed in claim 74)*
3. *The organic phase additionally has non volatile oil*
4. *Additives in claim 88.*

The patent '978 teaches ingredients 1a and 2-4 at page 2 and examples 1-2. The patent at page 3, lines 23-25 teach that the nail polish can be applied in a conventional applicator. The only difference between the patent and the application is the patent does not teach ingredient 2 in the nail/cosmetic compositions and in the form of a stick. However the patent '408 teaches 2 in the compositions as stick and its application in the field of nails. See cols. 3-4 for the polymer, which is the same, claimed in claim 62. See also col. 7, lines 10-20 for the various additives, see the same column, lines 49-5- for the application on the nails, see also col. 5 penultimate paragraph for the compositions in the form of stick, see col. 6 lines 10-15, and 35 for the non-volatile oil.

Art Unit: 1615

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of '978 and combine it with the *polymer* of '408, expecting beneficial effect to the nail. The motivation to use the *polymer* stems from the teachings of '408 that the compositions provide glossy and non-migrating film when applied on the nails. The idea of combining the ingredients flows logically from the art for having been used in the same nail care art. *Absent a showing the criticality of the polymer in the nail compositions Vs the example 1 of the GB patent giving un expected and superior results commensurate with the scope of claims*, the claims are rendered prima facie obvious over the combination of the patents.

Arguments

8. Applicant's arguments filed 3/23/03 have been fully considered but they are not persuasive.

Applicants argue that neither that GB patent nor the U.S. Patent '408 teach or even remotely suggest a motivation to combine the claimed invention and the GB patent teaches cosmetic compositions which has always glyoxal and the pending claims do not require glyoxal.

In response to the above argument, it is the examiners position that both the GB patent and the instant application are drawn to same nail compositions. There is suggestion in the GB patent with respect to the nail compositions at page 2, lines 20-33. The conventional ingredients are nitrocellulose, solvents, secondary resins, and other optional ingredients. Applicants are using the same nitrocellulose, as one of the polymers. The patent '978 teaches that secondary resins compatible with nitrocellulose are "Versamid". This is one of the choices for the first polymer. See page 13. Contrary to applicants statement at page 11 of the response, he examiner

Art Unit: 1615

has satisfied all the three conditions especially condition 1 and 3 for establishing prima facie case of obviousness. With respect to “ glyoxal “ not used in the compositions, **the expression “ comprising “ in the claims is inclusive of all the unrecited ingredients in major amounts.**

Applicant's argue that patent '408 does not supply the requisite motivation as the patent teaches compositions for treating keratin material like scalp, lips, eyelashes and eyebrows and the patent does not teach or suggest the combination of its disclosure with an element plucked and chosen from the GB patent.

In response to the above argument, the patent '408 teaches a film former, Film formers are used in the cosmetic art like nails, lips , eyelashes and skin. The patent teaches structured polymer and it suggests at col. 7, line 49 that it can be used for nails. With respect to the statement that the *motivation statement by the examiner does not even make sense from a technical perspective*, it is the examiners position that the film formers in the nail care art should satisfy the following characteristics for a satisfactory film. They are

1. even thickness
2. uniform color
3. good gloss
4. Adhesion to the nail
5. Satisfactory drying properties.

The patent does provide the motivation that the structured polymer provides glossy non-migrating film when applied to the nails. Non-migration would imply to the nail art as quick drying time. Therefore it is the examiners position that the claimed invention as a whole is obvious within the meaning of 35 U. S. C. 103 over the combination of the references.

Art Unit: 1615

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A VENKAT whose telephone number is 703-308-2439. The examiner can normally be reached on Monday-Thursday, 9:30-7:30: 1st and 2nd Friday off.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K PAGE can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592 for regular communications and 703-308-7924 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Application/Control Number: 10/046,568

Art Unit: 1615

Page 9


JYOTHSNA A VENKAT
Primary Examiner
Art Unit 1615

June 11, 2003